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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/041,815 | 10/18/2001 | Wolfgang Muhlbauer | GLAWE-06599 | 5359 |

7590 03/23/2004

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| EXAMINER |
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SHARAREH, SHAHNAM J

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| ART UNIT | PAPER NUMBER |
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1617

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,815

Applicant(s)

MUHLBAUER ET AL.

Examiner

Shahnam Sharareh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/05/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment filed on December 08, 2003 has been entered. Claims 12-25 are pending. Any rejection that is not addressed in this Office Action is considered obviated in view of the Amendment or Arguments.

Claim Rejections - 35 USC § 103

2. Claims 12, 14-17, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Futami et al US Patent 4,740,245 ('245)

Applicant's arguments with respect to this rejection have been fully considered but are not found persuasive. Applicant provides two different reasoning as to the incorrectness of the rejections of record, neither of which are persuasive.

First, Applicant argues that Examiner had issues a Restriction Requirement of claims in March 10, 2003 ("the Requirement") wherein the claims were declared to be patentably distinct. As Applicant reflects on the Requirement, Applicant appears to be misinterpreting the reasons set forth on the Requirement. Contrary to Applicant's interpretation, claims 12-25 of Group I were declared patentably distinct from Group II claims because they were towards methods of **dress**ing a wound, not methods of dressing a bone wound. (see the Requirement 1st para.). As properly argued then and now, the claims are capable of supporting different patents because on their face they have different function or effects; otherwise, they would have been duplicate of each other. Examiner still holds such reasoning to be valid and proper for the Requirement.

However, Restriction Requirements follow a different set of legal standards set forth in Chapter 800 of MPEP. They simply differ from those legal standards employed

for Examination of claims in view of prior art. In order to give life and meaning to the claims, the limitations of the claims are viewed in light of the specification. (see MPEP 2106). Accordingly, application of prior art to the claims is in view of each limitation and the scope thereof consistent with the specification. Since "a bone wound" as described in the specification encompass such terms as filing the root canal filing, Examiner had applied Futami to read on the claims as it is explained below.

Applicant's second argument is that the intended use of Futami is for root canal, which is not a bone wound. In response Examiner again states that the scope of the term "bone wound or trauma" was interpreted in light of the instant specification. The specification at page 5, lines 5-10 describes the scope of the bone wound or trauma. Accordingly:

...bone traumas such as, for example, fracture surfaces, drillings, cavities or the like. The term embraces, for example, root filling and use in the framework of fixing temporary coverings for tooth stumps.

Accordingly, a bone wound is interpreted to include "root canal or similar dental cavities."

Applicant also argues that according to the submitted dictionary definitions, the terms "bone," "tissue" and "root canal" are not directed to the analogous body regions. However, as discussed above, the recitations of the claims does not exclude application of the composition to dental cavity.

Further, Applicant's attention is drawn to the scope of the pending claims. The rejected claim does not require application of a composition on or in a bone or bone structure. Rather, the recitation of claim 12 is directed to applying a composition to "a bone wound." According to the specification "a bone wound" includes a root canal or

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dental cavity. Futami teaches composition for such use. Thus, the uses of Futami '245 compositions for their intended use render the instant claims prima facie obvious.

3. Claims 12, 14-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Futami et al US Patent 4,740,245 ('245) in view of Futami US Patent 5,051,130 ('130).

Applicant's arguments with respect to this rejection have been fully considered. The arguments relies on the premise that Futami does not teach bone wound. However, as reasoned above, Examiner ascertained the scope of the term "bone wound" to include dental injuries on tissues that lie on top of the bone, such as dental cavity or root canal. Nowhere does the claim exclude such injuries or limit the claim to application of the material on the bone or in the bone. Therefore, applicant's arguments are not commensurate with the scope of the claims.

Dr. Luck's Declaration filed under 37 CFR 1.132

4. The Declaration under 37 CFR 1.132 filed on December 8, 2003 is insufficient to overcome the obviousness rejection of claims 12-24 based as set forth in the last Office action because: It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

Conclusion

5. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 571-272-0630. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RUSSELL TRAVERS
PRIMARY EXAMINER